

REMARKS

By this amendment, claims 1-6, 8-13, and 16-19 are pending, in which claim 24 is newly presented. No new matter is introduced.

The Office Action mailed May 3, 2006 rejected claims 1-6, 8-13, and 18 under 35 U.S.C. § 103(a) as obvious based on *Bogard* (US 6,757,365 B1) in view of *Shaffer et al.*, and claims 16, 17, and 19 as obvious under 35 U.S.C. § 103(a) based on *Bogard* in view of *Shaffer et al.* and further in view of *Diacakis* (US Patent App. Pub. 2002/0120774 A1).

Regarding the rejections of record, Applicant respectfully traverses on the merits for the reasons provided below.

Independent claim 1 recites, “wherein the calling party specifies a **telephone number of the called party**; retrieving an **instant messaging identifier corresponding to the telephone number**.” Independent claim 18 recites, “a processor configured to **retrieve an instant messaging identifier corresponding to a telephone number of the called party** for establishment of the end-to-end voice session via an instant messaging application of the called party.”

The Office Action, on page 3, now applies *Shaffer et al.* to satisfy the above features, acknowledging that *Bogard* differs “in that the called party is identified by the called party’s IM username (e.g., ‘Buddy1’) rather than using a telephone number to retrieve the instant messaging identifier.” The motivation that is offered by the Examiner for modifying the *Bogard* system in view of *Shaffer et al.* rests on the fact that “use of a telephone number to identify an IM user, as taught by *Shaffer*” will “simplify the process of identifying a called party by using the called party’s telephone number rather than having to remember the called party’s IM username.” In the context of the references, Applicant submits that remembering a called party’s IM username, which typically has some semblance to the user (e.g., the user’s actual name), is more simple than remembering a telephone number. This is the general case with all numeric addresses; it is easier to

identify a called party by a name than a number (particularly, a string of 10 digits). The only reason the Examiner is providing a contrary position to this conventional view is to satisfy the claims.

Contrary to the Examiner's assertion that simplicity is what motivates the combination, the fact is that the proposed modifications to *Bogard*, if at all possible, would introduce an additional level of sophistication rather than simplify the *Bogard* system. *Bogard* is directed to a "method and apparatus for enabling users of a phone based speech activated system such as a voice portal to **communicate with users of an Internet based instant messenger (IM) service**," (Abstract; col. 1, line 65 – col. 2, line 5). Telephone users 300, 301 dial into voice portal 310 to access a voice application that interfaces with IM web server 308, (col. 7, lines 15-17). In this manner, telephone users 300, 301 register their presence on IM web server 308 with an IM identity, e.g., Buddy1, to allow other IM service users, e.g., computer user 302, to know they are online, (col. 10, lines 53-59; FIG. 1). Computer users 302 access IM web server 308 through web browsing and IM software applications, e.g., Internet Explorer™ and AIM™, which likewise log their presence into IM web server 308, (col. 5, lines 55-67). In essence, *Bogard* provides a unified approach that leverages traditional computer based IM services such that all communicating parties access one another by a computer based identity consisting of an instant message appearance.

Accordingly, nothing within *Bogard* would lend itself to associating a telephone number with computer user 302 as suggested by the Office Action. At no point does *Bogard* even imply that a computer user 302 is near a telephone. Further, because computer users 302 log onto traditional Internet based IM applications, any association with a telephone number would be contrived and forced. Further, Applicant does not understand how introducing a telephone number into the *Bogard* system would add any level of simplicity, particularly when no such capability is needed.

Furthermore, no support for the proposed combination exists within *Shaffer et al.* *Shaffer et al.* is directed to a “method and system for **adding a participant to a conference call**” in which the optimal call direction is established via a Call Optimization Application (COA), (Abstract). Within the *Shaffer et al.* system, a human user A at terminal entity A signals multipoint controller 118 to add a party C to an ongoing conference call on a given media transport channel, (col. 5, lines 53-60; col. 2, lines 39-46). A media transport channel is a channel sufficient to meet defined data transmission needs for an individual conference call, (col. 2, lines 3-5). After signaling multipoint controller 118, human user A can then enter the number of another terminal entity, e.g., terminal entity C, to extend an invitation to join the call, (col. 5, line 66 – col. 6, line 15). Subsequent to the request, multipoint controller 118 will extend the invitation to terminal entity C **over a non-media transport channel**, (col. 6, lines 16-23). A non-media transport channel is a channel **unable to support a conference call**, (col. 6, lines 37-42). This non-media transport channel occurs via an IM service connection, (col. 6, lines 47-60). Accordingly, multipoint controller 118 associates the telephone network number entered by human user A of terminal C with an IM service identifier associated with human C and extends the invitation to join the ongoing conference call, (col. 6, line 47-65; col. 7, line 34-54). Depending on the outcome of a COA cost analysis determining the optimal call direction, party C will be provided with a password via the non-media transport channel to call into the conference call over a media transport channel as in a “meet me” conference scenario, (col. 9, lines 20-36).

In essence, *Shaffer et al.* uses an IM service as a means to invite someone to join an ongoing conference call. This mode of communication is distinct from the end-to-end voice communication that occurs later over a media transport channel. Notably, the IM communication occurs over a channel unable to support end-to-end voice communications between the calling and called parties. Further, messages sent over the IM service are between party C and

multipoint controller 118, not between the calling and called parties. In the end, the *Shaffer et al.* system's association of a telephone network number with an IM identifier has nothing to do with establishing end-to-end voice communications between a calling party using a telephone connection and a called party using an instant messaging client.

It is submitted that *Bogard*, in fact, teaches away the combination with *Shaffer et al.* *Bogard* suggests introduction of IM services to the telephone side to provide a “buddy” experience for users to contact one another instead of by using traditional conference call methods, (*see generally* col. 1, line 55 – col. 2, line 5). *Shaffer et al.* presents such a conference call method, and is therefore taught away from by *Bogard*. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Applicant respectfully reminds the Examiner that it “is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *See In re Wesslau*, 147 USPQ 391 (C.C.P.A. 1965). *See also* M.P.E.P. § 2141.02. Moreover, it is impermissible to use the claimed invention as an instruction manual to piece together isolated disclosures within the prior art. *See, e.g., In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). Instead, the required motivation to combine the references must “be found in the prior art, and **not** based on applicant’s disclosure.” *See* M.P.E.P. § 2143.

Moreover, the Office Action provides no explanation of why or how one of ordinary skill in the art would modify the *Bogard* system based on the teachings of *Shaffer et al.*, but instead simply concludes that the combination is desirable. In drawing this conclusion, the Office Action has ignored the basic tenets of obviousness. In rejecting claim under 35 U.S.C. § 103, the Examiner

must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F. 2d 785, 165 USPQ 570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by *Graham v. John Deere Co.*, 86 S. Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and the reasonable expectation of success must stem from the prior art itself, as a whole. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Given the divergent objectives of the *Bogard* system and the *Shaffer et al.* system, it is questionable at minimum whether the voice portal 310 and telephone gateway 307 of *Bogard* can be successfully modified to accommodate the multipoint controller call optimization application (MC-COA) 702 utilized by *Shaffer et al.*

For at least the above reasons, Applicant respectfully submits that the combination of *Bogard* and *Shaffer et al.* is improper, and urges the indication that independent claims 1 and 18, along with claims 2-6 and 8-13 depending correspondingly therefrom, are allowable.

In addition, the impropriety of the *Bogard* and *Shaffer et al.* combination is not remedied by the introduction of yet another reference, *Diacakis*. The Office Action, on page 4, relies on *Diacakis* for supposedly teaching “the desirability of associating with an instant messaging identifier a time period during which the individual is present on the networks available to him, for example, instant messaging.” Applicant, therefore, respectfully requests withdrawal of the

obviousness rejection to dependent claims 16, 17, and 19, and the indication that these claims be allowed, at least for those reasons proffered above.

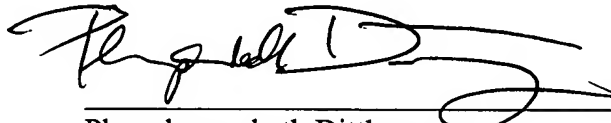
As for newly added claim 24, this claim recites "sending an instant message to the called party to determine whether the called party wants to establish the voice communication session with the calling party." Applicant respectfully submits that claim 24, which depends from claim 1, is allowable at least for those reasons proffered for the allowability of claim 1, as well as on its own merits.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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